

## **REMARKS**

The Office Action dated December 13, 2004, has been received and carefully noted. The following remarks are submitted as a full and complete response thereto. Claims 1, 2 and 5-14 are pending. Claims 1, 2, 5 and 12-14 have been allowed. Claims 6-11 are respectfully submitted for consideration.

The Applicants wish to thank the Examiner for allowing claims 1, 2, 5 and 12-14.

Claims 6, 7, 9 and 10 were rejected under 35 U.S.C. § 102(b) as being anticipated by Komaki et al. (U.S. Patent No. 5,185,730, "Komaki"). Claim 7 depends from claim 6, and claim 10 depends from claim 9. The Applicants respectfully submit that claims 6, 7, 9 and 10 recite subject matter that is neither disclosed nor suggested by Komaki.

Komaki discloses a method for writing data to, and reading data from, an optical disk that has address information written on its land between grooves or in its pregrooves.

With respect to claims 6 and 9, the Applicants submit that Komaki does not disclose or suggest the claimed features of the invention. Claim 6 recites removing means for removing an influence of the prepit based on the tracking error signal and an output of the prepit information detecting means from the tracking error signal. Claim 9 recites a removing circuit, which removes an influence of the prepit based on an output of the prepit information detecting circuit from the tracking error signal. The Office Action took the position that Komaki discloses removing the influence of the address signal from the tracking signal 17 and 15. In contrast, Komaki merely discloses a microcomputer, the processor thereof providing control over switching the signal

switching circuit 12, turning on and off the loop switch 15, and driving a kick pulse generation circuit 17 that generates kick pulses of which the pulse width and peak values cause the beam spot S to move by half of the land pitch "p" ( $p/2$ ) in the disk radius direction. See column 2, line 65 to column 3 line 4 of Komaki. There is no disclosure or suggestion that any influence of the prepit is removed from the kick pulse generation circuit 17 or the loop switch 15 in Komaki. As such, Komaki fails to disclose or suggest each and every feature of the invention as recited in claims 6 and 9.

According to U.S. patent practice, a reference must teach every element of a claim in order to properly anticipate the claim under 35 U.S.C. §102. In addition, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628,631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "Every element of the claimed invention must be arranged as in the claim . . . the identical invention, specifically, [t]he identical invention must be shown in as complete detail as contained in the claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989) (emphasis added). Accordingly, Komaki does not disclose or suggest removing means for removing an influence of the prepit based on the tracking error signal and an output of the prepit information detecting means from the tracking error signal as recited in claim 6, or a removing circuit which removes an influence of the prepit based on an output of the prepit information detecting circuit from the tracking error signal, as recited in claim 9. Accordingly, Komaki does not anticipate claims 6, 7, 9 and 10, nor are claims 6, 7, 9 and 10 obvious in view of Komaki.

Claims 6-11 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Office Action took the position that the claims contained subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. In particular, the Office Action took the position that the specification as originally filed did not provide support for the limitation of, removing the influence of the prepit based on the tracking signal, as claimed.

The Applicants respectfully direct the Examiner's attention to page 13, line 12 to page 15, line 15 of the specification as originally filed. This section of the specification discloses that the coefficient multiplier 77 and the subtractor 70 reduce the noise signal caused by the prepit 4 on the land 3 included in the original tracking error signal. The multiplier 77 and the subtractor 70 serve as removing means for removing an influence, or noise signal, of the prepit 4 on the land 3 from the tracking error signal 74. See Fig. 8b of the specification as originally filed. As such, the Applicants submit that the specification as originally filed provides support for the limitation of, removing means for removing an influence of the prepit based on the tracking error signal and an output of the prepit information detecting means from the tracking error signal.

Claims 6-11 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. As discussed above, the multiplier 77 and subtractor 70 serve as removing means for removing the influence of the prepit 4 from the tracking error signal 74. The prepit signal originates from the output (A + B) and the output (C + D). As such, the Applicants submit that the removing means for removing an influence of the prepit

based on the tracking error signal and an output of the prebit information detecting means from the tracking error signal is disclosed in Fig. 8b of the application as originally filed, and also, in the material from page 13, line 12 to page 15, line 15.

Claims 1, 2, 5 and 12-14 are allowed. Claims 7 and 8 depend from claim 6 and claims 10 and 11 depend from claim 9. As discussed above, Komaki fails to disclose or suggest each and every feature of the invention as recited in claims 6 and 9. The Applicants respectfully submit that these dependent claims are allowable at least because of their dependency from allowable base claims 6 and 9. Accordingly, the Applicants respectfully request allowance of claims 6-11 and the prompt issuance of a Notice of Allowability.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper,

may be charged to counsel's Deposit Account No. 01-2300, **referencing Attorney Dkt. No. 107156-00033.**

Respectfully submitted,



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Enclosure: Petition for Extension of Time (Three months)